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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/695,663

10/29/2003

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EXAMINER

SMITH, CHENEA

ART UNIT

PAPER NUMBER

2623

MAIL DATE

DELIVERY MODE

09/24/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/695,663

Applicant(s)

CHRISTOFALO ET AL.

Examiner

Chenea P. Smith

Art Unit

2623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 29 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

1. Claims 1-4 and 9 are rejected under 35 U.S.C. 102(e) as being anticipated by Liga et al. (US20030154128, hereinafter Liga).

Regarding claim 1, Liga discloses a system for inserting commands into a digital programming signal comprising a digital ad server (MPEG server, see [0029], lines 4-6 and [0030], lines 1-7) which generates at least one message (DVS 380 API message, see [0023], line 13) having an attached command (embedded additional data communicated to the PVR instructing the PVR of what to display during a fast-forward, see [0023], lines 20-21), and a digital splicer (inherent that a digital splicer is included since the message is of the DVS 380 API format) which receives the message from the ad server, extracts the attached command and splices the command into a digital transport stream is included since the command (inherent that

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the command including the frame is spliced into the digital transport stream since the command executed and a different frame is displayed during a fast-forward, see [0023], lines 14-21).

Regarding claim 2, Liga discloses a message which is in a DVS380 compliant format (see [0023], line 13).

Regarding claim 3, Liga discloses a DVS380 compliant message including at least one descriptor (inherent that a descriptor is included since descriptors are part of the standard format of a DVS 380 message, see [0023], line 13).

Regarding claim 4, Liga discloses a DVS380 splice request message (inherent that a splice request message is included since splice request messages are part of the standard format of the DVS 380 splicing technique, see [0023], line 13).

Regarding claim 9, Liga discloses a command spliced into the digital transport stream on a frame accurate basis (command instructs the device to play a specific frame at a specific time, see [0023], lines 14-21).

### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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3. Claims 5-8 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Liga et al. (US20030154128, hereinafter Liga), as applied to claim 1 above, and further in view of Applicant's conceded prior art.

Regarding claims 5-8 and 10, Liga fails to specifically disclose that the descriptor includes a field for inserting various commands, more than one commands and time indications as recited in the claims.

However, Applicant's admitted prior art at page 10 paragraphs 21 and 22 of the specification describe inserting commands in digital transmission systems. Although applicant indicated that the process "was not robust" it is a clear indication that the process of inserting digital commands in digital transmission systems was well known in the art.

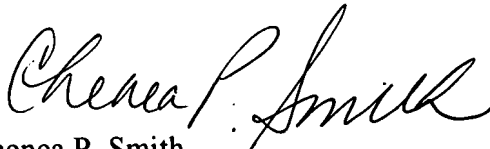
Therefore, it would have been obvious for a person having ordinary skill in the art at the time of the invention to modify Liga's system (if necessary) to include inserting various commands in the descriptor or other fields of a digital signal, as taught by applicant's conceded prior art, for the widely accepted benefit of commanding set top receivers to provide one or more particular advertisements from a plurality of advertisements.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chenea P. Smith whose telephone number is (571) 272-9524. The examiner can normally be reached on Monday through Friday, 7:30 am - 5:pm, EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Grant can be reached on (571) 272-7294. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
Chenea P. Smith  
9/12/2007

  
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